

Remarks

Claims 1-17 are pending in the application.

Claims 1 and 5 are amended to correct typographical errors.

Claim 1 is further amended to indicate that the composition is “non-emulsified.”

Claim 14 is amended to clarify the “component of inorganic origin.”

Claim Objections

The Examiner has objected to claims 1 and 5 because each claim includes an apparent typographical error. Claim 1 has been amended to correct the spelling of “hydroxyl,” and claim 5 has been amended to correct the spelling of “pentaerythritol.” Accordingly, Applicants respectfully request withdrawal of the standing objections.

Rejections under 35 USC § 103

The Examiner has rejected claims 1-7 and 9-10 as being obvious over US Patent No. 5,447,563 (“van Hoom”). The Examiner indicates that van Hoom discloses a release composition “comprising a fatty acid ester with between 4 and 24 carbon atoms” and “a neopentyl polyol containing three hydroxyl groups” in “a process involving application of such a release composition to moulds.” However, the Examiner concedes that van Hoom does not disclose the correct amount of water that is recited in claim 1. Nevertheless, the Examiner contends that the person having ordinary skill in the art “would have full faculty to select a preferred water amount tailored to [sic] composition’s purpose.” Applicants’ disagree, asserting that the skilled artisan would not modify van Hoom in the manner suggested by the Examiner to arrive at the invention defined by claims 1-7 or 9-10.

The Examiner suggests that the amount of water disclosed by van Hoom is not a critical feature of the composition described therein. Applicants respectfully point out that the opposite is true; the amount of water needed to practice the compositions of van Hoom is critical. Van Hoom is concerned with preparing “[o]ptimal concrete mould release agents [that] show a

critical balance between chemical and physical action” (col. 1, lines 39-40, emphasis added). That critical balance requires that the compositions are not “too reactive” nor have “poor hydrolytic stability” (col. 2, lines 58-60). Thus, Van Hoon discloses that certain esters “have the right chemical reactivity and can therefore fully replace mineral oil in oil-in-water concrete mould release compositions and exhibit even under basic conditions a good hydrolytic stability” (col. 2, lines 52-55, emphasis added). Simply stated, the compositions of van Hoon are emulsions, and more particularly, oil-in-water emulsions. Oil-in-water emulsions require a substantial amount of water, the continuous phase, in which oil can be dispersed.

In contrast, Applicants’ claimed invention is drawn to a method of using “non-emulsified” mould release compositions “containing less than 0.2% by weight water.” Applicants’ compositions are the antithesis of van Hoon. Simply, van Hoon is exclusively dedicated to providing emulsified compositions, while the claimed compositions are non-emulsified.

The Examiner contends that the person having ordinary skill in the art would modify the compositions disclosed by van Hoon and arrive at the instant invention. That basis for rejecting claims 1-7 and 9-10 is untenable. The Examiner points to van Hoon’s disclosure that the weight percent of ester can be in the range of 5-95%. However, all of the examples presented by van Hoon make it clear that the major component in the disclosed oil-in-water emulsions, not surprisingly, is water (see, e.g. Examples 1-7, 85% water; Example 9, 70% water; Example 8, 60% water). Applicants assert that the skilled artisan would seriously doubt that an oil-in water emulsion could be formed with only 5% water. Even assuming, *arguendo*, that the skilled artisan was forced to accept that unsupported lower limit, the already skeptical skilled artisan would have no motivation whatsoever to further decrease that value, and certainly would not decrease it to the limit of “less 0.2% by weight water” recited in Applicants’ claims.

The Examiner further argues that the skilled artisan would “select a preferred water amount tailored to [*sic*] composition’s purpose.” Applicants’ assert that van Hoon has already indicated the preferred water amount, and it is substantially higher than 5%, being as high as 60%, 70%, and 85%. The preferred amount of water must be at least sufficient to form an oil-in-water emulsion and therefore, the emulsion should be mostly water. Van Hoon is silent to non-emulsified compositions. Moreover, van Hoon has clearly indicated that the disclosed compositions are already optimized, having “the right chemical reactivity” and “good hydrolytic

stability.” Thus, the person having ordinary skill in the art would in fact be dissuaded from making any changes to the disclosed compositions, including being deterred from changing the already unrealistically low amount of water. Accordingly, nothing in van Hoon suggests to the person having ordinary skill in the art that the non-emulsified compositions claimed here would have any purpose as mould release compositions.

Accordingly, Applicants respectfully aver that the Examiner has not provided any basis for the contention that van Hoon would, or in fact could be altered to arrive at Applicants’ invention. To do so would be to ignore the teachings of van Hoon and completely destroy the object of that invention described by van Hoon, namely to prepare oil-in-water emulsions. Applicants request reconsideration of the standing rejection of claims 1-7 and 9-10 as being obvious over van Hoon, and its withdrawal of this rejection.

The Examiner has also rejected claims 2-4 and 11-17 as being obvious over van Hoon in view of US Patent No. 5,523,025 (“Erilli”). The Examiner recognizing that among its other limitations, van Hoon is also silent to the addition of terpene derivatives and/or components of inorganic origin to the compositions disclosed therein. Accordingly, the Examiner contends that the person having ordinary skill in the art would consult Erilli and further modify van Hoon by adding those agents. Applicants respectfully disagree; the combination of van Hoon and Erilli is incapable of rendering claims 2-4 and 11-17 obvious.

Erilli is completely silent to mould release agents, and instead is drawn to an improved light duty liquid cleaner “designed in particular for cleaning dishware and which is effective in removing grease soil and/or bath soil and in leaving unrinsed surfaces with a shiny appearance” (col. 1, lines 5-8, emphasis added). The Examiner suggests that the skilled artisan would blindly extract the terpene derivatives and/or components of inorganic origin from Erilli and modify van Hoon to arrive at Applicants’ invention. Applicants assert that the Examiner has engaged in improper hindsight construction. Simply, the skilled artisan working in the area of mould release compositions would not consult the art of liquid cleaning products disclosed by Erilli. Be that as it may, as stated above, van Hoon is exclusively directed to emulsified compositions. Similarly, Erilli is exclusively directed to microemulsions. Applicants’ claims 2-4 and 11-17 recite a “non-emulsified composition.” Accordingly, nothing in Erilli can overcome the insufficiencies of van Hoon.

The Examiner has also rejected claim 8 as being obvious over van Hoorn in view of US Patent No. 6,176,914 ("Feustel"). The Examiner recognizing that among its other limitations, van Hoorn is also silent to the inclusion of esters of tall oils in the compositions disclosed therein. Accordingly, the Examiner contends that the person having ordinary skill in the art would consult Feustel and further modify van Hoorn by adding those esters. Applicants respectfully disagree; the combination of van Hoorn and Feustel is incapable of rendering claim 8 obvious.

Feustel is completely silent to mould release agents, and instead is drawn to "a substitute for aromatic solvent constituents in solvents for printing inks" (col. 1, lines 7-8, emphasis added). The Examiner suggests that the skilled artisan would blindly extract the tall oil esters from Feustel and modify van Hoorn to arrive at Applicants' invention. Applicants assert that the Examiner has engaged in improper hindsight construction. Simply, the skilled artisan working in the area of mould release compositions would not consult the art of printing inks disclosed by Feustel. In any case, as stated above, van Hoorn fails to teach non-emulsified compositions, and nothing in Feustel can overcome the insufficiencies of van Hoorn.

Therefore, Applicants respectfully assert that the Examiner has not provided any basis for the contention that van Hoorn would, or in fact could be combined with either of Erilli or Feustel to arrive at Applicants' invention. In both the case of Erilli and Feustel, the combination is improper. Further, in both cases, the combination simply fails to reach the required elements of Applicants' claims, namely a non-emulsified composition for use in mould release. Applicants request reconsideration of the standing rejection of claims 2-4 and 11-17 as being obvious over van Hoorn in view of Erilli, and of claim 8 as being obvious over van Hoorn in view of Feustel, and withdrawal of these rejections.

Conclusion

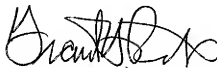
Applicants believe that each of the Examiner's objections and rejections have been successfully overcome, and consider that the instant applicant is in condition for allowance. Hence, Applicants respectfully request that the Examiner pass the instant application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Application No. 10/550,127
Attorney-Docket No. 38624-100474

It is further requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response with the fee for such extensions and shortages in other fees, being charged, or any overpayment in fees being credited, to the account of Barnes & Thornburg LLP, Deposit Account No. 12-0913 (Attorney Docket No. 38624-100474).

Respectfully submitted,

BARNES & THORNBURG LLP



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